

## **REMARKS**

Reconsideration of this application, as amended, is respectfully requested.

The independent claims have been amended to include the language of claims 55-58, respectively. All rejections based in part on Kulkarni are rendered moot.

Additionally, the amendments to the claims make the rejections of claims 26, 29, 31, 34, 55 and 56 over the combination of Bristowe, Sobata and Palm moot.

Claims 26-35, 55 and 56 were rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. Applicants respectfully traverse. The parent PCT publication teaches clearly on page 2, lines 21 to 25 in German language "und ein leitfähiges pigment" (and one (which equals an) electroconductive pigments). Example 2 of the specification shows the use of only one type of such pigments (iron phosphide). See also page 2, par. 4, last line of the English specification (...and a conductive pigment). Withdrawal of this rejection is respectfully requested.

Claims 26, 29, 31, 34, 55, and 56 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over the combination of Bristowe in view of Sobata and Palm. Applicants respectfully submit that this rejection no longer applies to those claims, as amended or canceled.

A new set of claims based on the subject matter of claim 55 is presented for consideration. With respect to the rejection of claim 55 and others as allegedly obvious over the combination of Bristowe in view of Sobata and Palm, applicants respectfully submit that there is no motivation to combine the references as suggested by the Examiner.

Bristowe discloses a vinyl urethane resin made of a polyoxyalkylene bisphenol A. He does mention use of additives to change physical properties of the resin, including magnetizable iron oxide. Electroconductive properties are not discussed.

Sobata teaches at col 9, lines 29-33 that the spot-weldability can be improved by limiting the aromatic ring content of the binder resin to 0-50% (see col. 10, line 17). Examples of such resins are provided at lines Col. 10, 19-25. According to Sobata, if electrically conductive

pigments are added in amounts below 30% or above 70% deleterious effects result (see col. 11, lines 44-45). Also, a wax must be added in such coatings (see col 9, line 47-col 11). Thus, Sobata teaches away from using amounts less than 30% and amounts greater than 70% of electrically conductive pigments, and the claimed range of Applicants is, therefore, not suggested by Sobata.

Furthermore, it is submitted that there is no reason to add electrically conductive pigments to Bristowe's composition based on Sobata's teaching, e.g., in the amounts described by Sobata, because Sobata teaches to minimize the aromatic ring content of the coatings to 0-50% and to include a wax.

To the extent Sobata suggests urethane resins in Col 10, line 20, it is not believed that one would choose to use the vinyl ester urethane of Bristowe, which is based on a biphenyl-containing resin, based on Sobata's teaching to minimize the aromatic ring content in the molecule to 50% or less.

Palm adds nothing to overcome the deficient combination of Bristowe and Sobata.

In view of the foregoing, allowance is respectfully requested.

Applicants reserve the right to prosecute any and all presently unclaimed subject matter in related continuing applications.

Any fees due to enter this amendment or to maintain pendency of this application,  
authorization is given to charge deposit amount no. 50-0624.

Respectfully submitted,

FULBRIGHT & JAWORSKI, L.L.P.

A handwritten signature in black ink, appearing to read "James R. Crawford", is written over a horizontal line.

James R. Crawford  
Attorney for Applicants  
Registration No. 39,155

FULBRIGHT & JAWORSKI, L.L.P.  
666 Fifth Avenue  
New York, New York 10103  
(212) 318-3148